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PATENT

Docket No. 050-96-018

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Ilan Golecki

: Group Art Unit: 1755

Serial No. 09/828,048
Filed: April 6, 2001

: Examiner J. Brunzman

For: COATINGS AND METHOD FOR PROTECTING CARBON-CONTAINING
COMPONENTS FROM OXIDATION

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

ELECTION

This is in response to a written requirement for restriction made in an office action dated May 5, 2003. According to the office action, restriction is required between claims 1-11 and 13 drawn to a component classified in class 106, subclass 287.1 (Group I); claims 12 and 18-21 drawn to a method classified in class 427 (Group II), subclass 585; and claims 14-17 drawn to a method classified in class 428, subclass 408 (Group III).

The undersigned had a telecon with Examiner Patel (703-308-4412) on September 13, 2002. A provisional election with traverse of claims 1-11 and 13 (Group I) was made. This provisional election of claims 1-11 and 13 is hereby affirmed.

The office action indicates that claims 1, 10, 11 and 13 are generic, and now requires additional restriction between the various species of claims 2-9. A provisional election of the species recited in claim 5 is respectfully made.

The original restriction requirement between the claims of Groups I and III is respectfully traversed. The office action cites MPEP 806.05(d) to support the restriction requirement between Groups I and III. However, MPEP 806.05(d) is not applicable, since claims 1 and 14 do not recite two different subcombinations that are disclosed as being usable in a single combination.

The applicable section is MPEP 806.05(c), which states

"In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability; and

(B) the subcombination can be shown to have utility either by itself or in other and different relations. When these factors cannot be shown, such inventions are not distinct.

Claims 1 and 14 both recite a coating including a material selected from the group consisting of non-stoichiometric silicon and carbon; non-stoichiometric silicon and oxygen; non-stoichiometric silicon and nitrogen; compounds of silicon, oxygen, and carbon; compounds of silicon, oxygen and nitrogen; compounds of silicon, nitrogen, and carbon; and silicon. Therefore, the combination (claim 14) requires the particulars of the subcombination (claim 1). Clearly, criteria (A) of MPEP 806.05(c) is not satisfied. Accordingly, the restriction requirement of Groups I and III should be withdrawn.

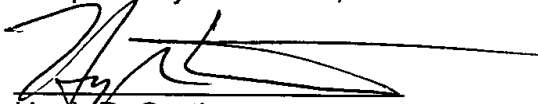
The original restriction requirement between the claims of Groups I and II is respectfully traversed. The office action relies upon for MPEP 806.05(d) for the restriction requirement. However, MPEP 806.05(d) does not support the restriction requirement, since claims 13 and 18 do not recite two different subcombinations that are disclosed as being usable in a single combination.

Moreover, claim 12 of the Group II claims necessarily depends from claim 1 of the Group I claims. Allowance of claim 1 will necessarily result in the allowance of claim 12.

The office action set a shortened statutory period for response of ZERO months. However, this contravenes MPEP 710.02(b), which states that a shortened statutory period for response may not be less than 30 days. Because this response to a first written action was filed within 30 days of the office action, a petition for an extension of time is not required.

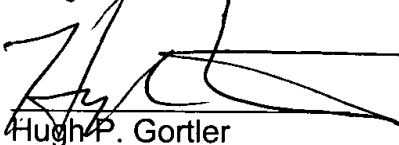
For these reasons, it is respectfully requested that the original requirement for restriction be withdrawn and that examination of claims 1-21 proceed immediately.

Respectfully submitted,



Hugh P. Gortler
Reg. No. 33,890

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Arlington, VA 22313-1450 on **June 4, 2003**.


Hugh P. Gortler

Honeywell International Inc.
Law Department, AB2
P.O. Box 2245
Morristown, NJ 07962-9806
(310) 512-4885

Date: June 4, 2003